REMARKS

Reconsideration and withdrawal of the rejections of the claims, in view of the amendments and remarks herein, is respectfully requested. Claims 1 and 36 are amended. Claims 1-83 are now pending.

The objection to claim 36 noted at page 3 of the Office Action is obviated by the amendment to claim 36.

The 35 U.S.C. § 112 Rejections

Claims 1-13 and 36 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserts that while the specification provides general information on the nature of the restriction enzyme sites which are utilized, there is no disclosure of the precise structure of a representative number of restriction sites that are encompassed by the claims. This rejection is respectfully traversed.

The Examiner is requested to consider Applicant's detailed disclosure, which exemplifies numerous restriction enzymes ("first" restriction enzymes) which have infrequent restriction sites in cDNAs or open reading frames from at least one species and generate complementary single strand DNA overhangs; restriction enzymes ("second" restriction enzymes) which have infrequent restriction sites in cDNAs or open reading frames from at least one species and generate ends that are not complementary to the overhangs generated by a first restriction enzyme; restriction enzymes ("third" restriction enzymes) which generate complementary single strand DNA overhangs that are complementary to the single strand DNA overhang generated by a first restriction enzyme; and restriction enzymes ("fourth" restriction enzymes) which generate ends that are not complementary to the ends generated by the first or third restriction enzyme but can be ligated to the ends generated by the second restriction enzyme. For instance, see pages 11 and 35-37 and Figure 5 in the specification, which exemplify restriction enzymes useful in the claimed methods.

Therefore, withdrawal of the § 112(1) "written description" rejection is respectfully requested.

Claims 1-13 and 36 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicant regards as the invention. Specifically, the Examiner asserts that 1) "infrequent" is a relative, ill-defined term, and 2) it is not clear what is intended by digestion with the second restriction enzyme site. These rejections, as they may be maintained with respect to the pending claims, are respectfully traversed.

The amendment to claim 1 to delete "site" in line 11 moots the second basis for the § 112(2) rejection.

With regard to "infrequent," the Examiner is requested to consider that U.S. Patent No. 5,595,895, a document cited against the pending claims, refers to "a restriction enzyme with an infrequently occurring site" (column 7, lines 3-4) and "infrequent cutter" (column 14, line 63). Thus, the term "infrequent" with reference to the frequency of sites recognized by a restriction enzyme, is a term which is conventionally used in the art.

Moreover, Applicant's specification discloses methods to identify the frequency of restriction sites and exemplifies frequencies for "infrequent cutter" (see pages 10 and 37-40, and Figures 4-5, in the specification). Therefore, the metes and bounds of the term “infrequent” in the context of the claims is clear.

Thus, withdrawal of the § 112(2) rejection is respectfully requested.

The 35 U.S.C. § 102 Rejection

Claims 1 and 36 were rejected under 35 U.S.C. § 102(b) as being anticipated by Miki et al. (U.S. Patent No. 5,595,895). This rejection is respectfully traversed.

The '895 patent discloses a vector for directional cloning, e.g., of cDNAs into λ phage vectors or into *Bst*XI sites in plasmids, where the vector has two sites for a restriction enzyme that, after digestion, yields two different non-symmetrical 3' extensions. For instance, the vector has sites which are cleaved by *Sfi*I (creating ends B^- and A^+; see Figures 1A-B and 2B) and the linear cDNA insert is modified to contain ends complementary to those ends (A^- and B^+ ends; see Figure 2A).

In contrast, Applicant's method includes the use of two vectors each with a different selectable marker.

Accordingly, withdrawal of the § 102(b) rejection is respectfully requested.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6959 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date December 5, 2006 By ______________________
Janet E. Embretson
Reg. No. 39,665

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of December 2006.

Dawn M. Poole
Name

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Signature